

REMARKS

Following entry of this amendment, claims 8 and 29 to 33 will be pending in the application. Claim 8 is withdrawn from consideration. Claims 1 to 6 have been canceled without prejudice or disclaimer. Claims 29 to 33 have been added. Support for new claim 29 can be found in the specification, e.g., at page 4, lines 5 to 9; and at page 6, lines 8 to 19. Support for new claim 30 can be found in the specification, e.g., at page 6, lines 8 to 9, and at original claim 5. Support for new claim 31 can be found in the specification, e.g., at page 2, lines 31 to 34, and at original claim 6. Support for new claim 32 can be found in the specification, e.g., at page 28, lines 20 to 22, and at original claim 7. Support for new claim 33 can be found in the specification, e.g., at page 28, lines 5 to 7. New claims 29 to 33 add no new matter. Finally, withdrawn claim 8 has been amended to depend from new claim 29.

Applicants submit that the proposed new claims 29 to 33 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Those claims also place the application in better condition for allowance or appeal. Thus, entry of the amendment is respectfully requested.

Double Patenting

The Examiner provisionally rejected claims 1 to 6 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 to 5 and 19 of U.S. Application Serial No. 08/728,963 (the '963 application). Action at page 3, item no. 7. The Examiner alleged that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the

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instant claims are drawn to a library of cultured eukaryotic cells with vectors integrated into a cellular transcript." *Id.*

Applicants respectfully traverse the double patenting rejection over claims 1 to 5 and 19 of the '963 application. That application was abandoned as evidenced by the Notice of Abandonment mailed June 27, 2003.

The Examiner provisionally rejected claims 1 to 6 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 to 6 and 28 of copending U.S. Application Serial No. 09/570,923 (the '923 application). Action at page 4, item no. 8. The Examiner alleged that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are drawn to a library of cultured eukaryotic cells with vectors integrated into a cellular transcript." *Id.*

Applicants respectfully traverse the double patenting rejection over claims 1 to 6 and 28 of the '923 application. Those claims were canceled without prejudice or disclaimer in an Amendment filed May 6, 2002.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1 and 2 under 35 U.S.C. § 102(a) as allegedly being anticipated by Gruber. Action at page 5, item no. 11. Specifically, the Examiner alleged that

Gruber et al. taught (see especially the abstract, introduction and figures) a library of cultured eukaryotic cells transfected with vectors which are stably integrated internally to a cellular transcript, and 5' to a cellular transcript. The cells of Gruber et al. are treated with a collection of

genomic DNA's and a collection of cDNA's which have been cloned into a library of vectors. The library of vectors is transformed into the cultured cells as recited into the abstract, at three locations in the *nitA* gene in the genome of the cell. The insertions were as shown in Figure 2B, within an exon, or 5' to an exon in a cellular transcript providing spliced foreign exons into the transcript.

Id.

Applicants respectfully traverse. Solely to expedite prosecution and without acquiescing to the rejection, applicants have canceled claims 1 and 2. Applicants propose to add claims 29 to 33. Applicants will address the rejection with respect to the added claims.

Claim 29 recites

A library of cultured eucaryotic cells comprising at least two subpopulations of cells, wherein the at least two subpopulations of cells comprises

(a) a first subpopulation of cells, wherein each cell has a first vector integrated nonspecifically into its genome, wherein the first vector mediates the splicing of a foreign exon internal to a cellular transcript; and

(b) a second subpopulation of cells, wherein each cell has a second vector integrated nonspecifically into its genome, wherein the second vector mediates the splicing of a foreign exon 5' to an exon of a cellular transcript.

Claims 30 to 33 depend from claim 29 and recite the library of claim 29, wherein the eucaryotic cells are animal cells, mammalian cells, rodent cells, and mouse cells, respectively.

In contrast to the claimed invention, Gruber discusses only four transformants (see, e.g., Figures 5 and 6), which were isolated and characterized separately. Gruber does not discuss a library of cultured eucaryotic cells comprising at least two subpopulations of cells. Gruber also does not discuss a subpopulation of cells, wherein cells of the subpopulation have a vector integrated nonspecifically into their genomes. Rather, Gruber only characterized one transformant from each of the transformed

vectors and failed to determine where the vector was integrated into the transformant's genome. Thus, Gruber does not teach a vector integrated nonspecifically. For at least those reasons, applicants assert that Gruber does not anticipate claims 29 to 33.

Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(a) in view of Gruber.

The Examiner rejected claims 1 to 6 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,679,523 (the '523 patent). Action at page 6, item no. 13. Specifically, the Examiner alleged that "US 5,679,523 (Li et al.) taught (see especially columns 4 and 7 and the claims) a library of cultured eukaryotic cells transfected, infected or retrotransfected with vectors which are stably integrated internally to a cellular transcript, and 5' to a cellular transcript in a mammal (see column 9 and the claims)." *Id.*

Applicants respectfully traverse. Solely to expedite prosecution and without acquiescing to the rejection, applicants have canceled claims 1 to 6. Applicants propose to add claims 29 to 33. Applicants will address the rejection with respect to the added claims, which are discussed above.

Applicants assert that the '523 patent fails to teach a library of cultured eucaryotic cells comprising at least two subpopulations of cells, wherein the at least two subpopulations of cells comprises a first subpopulation of cells having a first vector integrated nonspecifically into their genomes and a second subpopulation of cells having a second vector integrated nonspecifically into their genomes. Rather, the '523 patent discusses cells having a "gene search construct" introduced into their genomes,

with an optional second construct introduced into the *same cells*, where the second construct expresses a marker gene and a factor that transactivates the first construct. See the '523 patent at column 4, lines 5-42. For at least that reason, applicants assert that the '523 patent does not anticipate claim 29. Claims 30 to 33 depend from claim 29 and are therefore not anticipated for at least the reason discussed for claim 29.

Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e) in view of the '523 patent.

Applicants respectfully request that this Amendment and Response be considered by the Examiner. Applicants respectfully assert that the present application is in condition for allowance and request that the Examiner issue a timely Notice of Allowance. If the Examiner does not consider the application to be allowable, the undersigned requests that, prior to taking action, the Examiner call her at (650) 849-6656 to set up an interview.

Please grant any extensions of time required to enter this Amendment and Response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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